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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR   | ATTORNEY DOCKET NO.  | CONFIRMATION NO. |
|-----------------|-------------|--|----------------------|------------------|
| 10/575,293      | 04/12/2006  | Becky Bossidan   | 2003005503           | 1337             |
| 22879           | 7590        | 10/10/2008<br>HEWLETT PACKARD COMPANY<br>P O BOX 272400, 3404 E. HARMONY ROAD<br>INTELLECTUAL PROPERTY ADMINISTRATION<br>FORT COLLINS, CO 80527-2400 |                      |                  |
|                 |             |  | EXAMINER             |                  |
|                 |             |  | RODEE, CHRISTOPHER D |                  |
|                 |             |  | ART UNIT             | PAPER NUMBER     |
|                 |             |  | 1795                 |                  |
|                 |             | NOTIFICATION DATE  | DELIVERY MODE        |                  |
|                 |             | 10/10/2008   | ELECTRONIC           |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

JERRY.SHORMA@HP.COM  
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|                              |                                      |  |
|------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/575,293 | <b>Applicant(s)</b><br>BOSSIDAN ET AL. |
|                              | <b>Examiner</b><br>Christopher RoDee | <b>Art Unit</b><br>1795                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 28 July 2008.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-14,16-18,20 and 22-26 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-14,16-18,20 and 22-26 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/06)  
Paper No./Mail Date 7/28/08

4) Interview Summary (PTO-413)  
Paper No./Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Objections***

Claim 26 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 26 specifies a black liquid toner comprising the toner particles in accordance with claim 25. Claim 25 is directed to a method of using a toner. Consequently, claim 26 does not include all the limitations of claim 25 (i.e., it does not recite the process of imaging steps) and, as such, fails to further limit claim 25.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-14, 16-18, 20, and 22-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Independent claim 1 has been amended and new independent claims 24 and 25 have been submitted to include a limitation "the printing toner exhibits an optical density fading of less than 10.5% when exposed to a light having a spectrum of wavelengths from about 270 to about 800 nanometers for a period of time over 200 hours".

A review of the specification shows that the colorimetry values used to determine the optical density fading are calculated at a period of "about 216 hours" (spec. p. 6, l. 4-5). The sole inventive composition tested was an image printed by an ink (col. 6, l. 10-13) and the optical density fading was 10.3 % (spec. p. 6, l. 12 ; and Table on page 5). These disclosures only provide testing conditions of "about 216 hours" and not all values "over 200 hours" as specified in the claims. This range of over 200 hours includes values of just over 200 hours up to a month, a year, and more. These testing times are not disclosed by the specification. Further, the specification fails to disclose fading of less than 10.5 %. The specification discloses a fading value of 10.3% for one liquid toner composition, but not values of from zero to less than 10.5 % for both dry and liquid toners.

The claims as presented contain new matter and are not described by the specification.

Claims 1-14, 16-18, 20, and 22-26 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for liquid toners having a change in optical density of 10.3 % after about 216 hours of exposure, does not reasonably provide enablement for all toners, liquid and dry, having a change in optical density of as little as zero or other small values for all exposures of 200 hours or more. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

As noted above, the specification discloses a single inventive black liquid toner composition having a change in optical density of 10.3 % after about 216 hours of exposure. The instant claims include all black toners, liquid, dry, and aerosol, that have an optical density fading of less than 10.5% when exposed to a light having a spectrum of wavelengths from about 270 to about 800 nanometers for a period of time over 200 hours. The instant

specification discloses a single composition having these characteristics produced in the manner specified on specification page 4. The specification teaches that the effects of the invention are achieved by combining a carbon black colorant with other colorants, such as a blue or violet pigment (spec. p. 3, l. 4-9). This limited disclosure does not provide sufficient teaching of how to obtain an optical density fading of less than 10.5% when exposed to a light having a spectrum of wavelengths from about 270 to about 800 nanometers for a period of time over 200 hours. The artisan contemplating the claims would have insufficient guidance of how to obtain optical density fading values of, for example, 1%, 5%, or 10% for time periods of 500 hours, 1000 hours, and one year.

As noted in the traversal of the art rejection, applicants take the position that optical fading is dependent on many factors (see response p. 13) including the color of the carbon black, the color of the available pigments, the light fastness of the pigments, and the effect of the polymer. The specification, however, provides guidance of only one liquid toner formulation that has the carbon black, other pigments, and resin disclosed. No other guidance of the correct combination of components is provided. Given applicants statement in the remarks and in view of the specification, it is readily apparent that the specification provides insufficient guidance of how to select the correct carbon black, correct pigments, and correct polymer to produce a liquid, dry, and aerosol toners encompassing a reasonable amount of the range of an optical density fading of less than 10.5% when exposed to a light having a spectrum of wavelengths from about 270 to about 800 nanometers for a period of time over 200 hours.

Although experimentation is permitted when considering the enablement requirement of section 112, the obligation is on applicants to provide reasonable guidance to compositions that will obtain the claimed results. In this situation, there is insufficient guidance of how to combine pigments in a liquid black toner to obtain other than a change in optical density of 10.3 % after

about 216 hours of exposure. Although the level of skill is high in the toner art, the predictability is low, particularly where the claims include features substantially different from those disclosed.

The artisan would be faced with undue experimentation of how to obtain the toners, dry, liquid, and aerosol, for the scope of the claims.

### **Conclusion**

Pending resolution of the issues under section 112, first paragraph, above, the previously applied art rejections are withdrawn. However, they may be reapply if the claims are brought into compliance with section 112.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher RoDee whose telephone number is 571-272-1388. The examiner can normally be reached on Monday to Thursday from 5:30 to 4:00 Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher RoDee/  
Primary Examiner  
Art Unit 1795

10 October 2008